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10/687,494

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EXAMINER

LIPMAN, BERNARD

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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARC HUSEMANN and
THILO DOLLASE

Appeal 2008-0511
Application 10/687,494
Technology Center 1700

Decided: January 30, 2008

Before CHARLES F. WARREN, THOMAS A. WALTZ, and
JEFFREY T. SMITH, *Administrative Patent Judges*.

WALTZ, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the Primary Examiner's final rejection of claims 1-5, 7, and 8, which are the only claims pending in this application. We have jurisdiction pursuant to 35 U.S.C. § 6(b).

According to Appellants, the invention is directed to an injection molded, compression molded, blow molded, or roto molded product

comprising one or more block copolymers based on polyacrylate and having inherent pressure-sensitive adhesion properties (Br. 2). Independent claim 1 is illustrative of the invention and a copy of this claim is reproduced below:

1. An injection moulded, compression moulded, blow moulded or roto moulded product comprising one or more block copolymers based on polyacrylate or mixtures comprising such block copolymers, and having inherent pressure-sensitive adhesion properties.

The Examiner has relied on the following prior art references as evidence of unpatentability:

Everaerts	WO 00/39233	Jul. 6, 2000
Remmers	US 6,430,898 B1	Aug. 13, 2002

ISSUE ON APPEAL

Claims 1-5, 7, and 8 stand rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Everaerts and in view of Remmers (Ans. 3).

Appellants contend that those skilled in the art understand that, because of the nature of molds and processes of molding, resulting products of the claim can have specific shapes not obtainable by simple compression molding as in Everaerts or pouring into an open mold as in Remmers (Br. 3). Appellants further contend that the products of the claims are “distinctly different” from those of the references because the resulting shaped features cannot be produced by Everaerts or Remmers (Br. 3, 4).

The Examiner contends that Appellants “accept the fact” that Everaerts teaches the same polymers as claimed, and the “issue contested” is whether the claims require a product with additional structure not disclosed

by the product of Everaerts or rendered prima facie obvious by the “bricks” of Remmers in combination with Everaerts (Ans. 3).

Accordingly, we determine that the issue presented from the record in this appeal is as follows: Does claim 1, as properly construed, require additional structure not disclosed by the product of Everaerts alone, or the combination of Everaerts and Remmers?¹

We determine that the Examiner has established a prima facie case of anticipation/obviousness in view of the reference evidence, which prima facie case has not been adequately rebutted by Appellants’ arguments. Therefore, we AFFIRM the rejections on appeal essentially for the reasons stated in the Answer, as well as those reasons set forth below.

OPINION

Since Appellants do not contest or dispute any of the Examiner’s factual findings from Everaerts or Remmer (Br. 3-4; Ans. 3), we do not repeat any findings here but adopt the Examiner’s findings of fact from the record in this appeal (Final Office Action dated Sep. 7, 2006; Final Office Action dated Jan. 18, 2005, p. 4).

As discussed above, the dispositive issue in this appeal relates to claim construction of the introductory terms “injection moulded, compression moulded, blow moulded or roto moulded” relative to the claimed product. *See Gechter v. Davidson*, 116 F.3d 1454, 1457, 1460 n.3 (Fed. Cir. 1997) (Implicit in any review of the Examiner’s anticipation or obviousness analysis is that the claim must first have been correctly

¹ We determine that Appellants have not presented any arguments to a particular claim with any reasonable specificity (Br. 3-4). Therefore, we select claim 1 from the group of claims and decide the grounds of rejection based on this claim alone. *See* 37 C.F.R. § 41.37(c)(1)(vii).

construed to define the scope and meaning of each contested limitation). Accordingly, we begin by construing these disputed limitations. We determine that these disputed terms relate to the *process of making* the claimed product, i.e., the claimed product is made from a polyacrylate based block copolymer by injection molding, compression molding, blow molding, or roto molding. However, the claims are directed to a *product*. A product-by-process claim, although reciting the subject matter of the claim in terms of how it is made, is still a product claim. It is the patentability of the *product* claimed which must be established. *See In re Hirao*, 535 F.2d 67, 69 (CCPA 1976); *In re Wertheim*, 541 F.2d 257, 271 (CCPA 1976). A rejection under § 102/§ 103 is proper when the prior art discloses a product that appears to be either identical with or only slightly different from the product claimed. If the Patent Office has reason to believe the prior art product is either identical with or only slightly different from the claimed product, the burden shifts to Appellants to prove that the prior art products do not possess the characteristics relied on by the claimed product. *See In re Fitzgerald*, 619 F.2d 67, 70 (CCPA 1980); *In re Best*, 562 F.2d 1252, 1255 (CCPA 1977); *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990). On the undisputed factual record in this appeal, we determine that the product of Everaerts is identical to the claimed block copolymer based on polyacrylate, with at least some inherent pressure-sensitive adhesion properties.² We determine that the introductory process limitations do not further restrict the claimed product. As correctly stated by the Examiner (Ans. 3-4), the

² *See* Everaerts, Abstract; 5:13-21 and 27-30; 6:7-31; and 11:18-23. We also note that Everaerts discloses prior art patents to Bayard relating to block copolymers based on polyacrylates useful in injection-molded articles (2:23-30). It does not appear that these patents have been considered by the Examiner on the record of this application.

products as claimed *generally* have a different structure than the prior art product but this is not always the case. In Appellants' own words, "the resulting products *can* have specific shapes not obtainable" by the processes disclosed by the applied prior art (Br. 3, italics added, implying that the resulting products may also have the same shapes as the applied prior art). We determine that the mere recitation of the general process of making the product does not give the product any additional structure not found in the applied prior art.

In view of our claim construction discussed above, we determine that the Examiner has established a prima facie case of anticipation/obviousness in view of the reference evidence, which prima facie case has not been adequately rebutted by Appellants' arguments. Therefore we affirm the rejections on appeal.

The decision of the Examiner is affirmed.

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Application 10/687,494

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

tf/lb

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